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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,899	02/15/2001	Shouichi Gotoh	MTS-3244US	6384

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EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/783,899

Applicant(s)

GOTOH ET AL.

Examiner

John L Young

Art Unit

3622

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

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## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **IMPROPER MULTIPLE DEPENDENT CLAIMS — 37 CFR 1.75( c )**

2. Multiple dependent claims 34 & 35 are objected to under 37 CFR 1.75( c ) as being in improper form because a multiple dependent claims cannot depend from any other multiple dependent claim. Notwithstanding this objection, claims 34 & 35 have been rejected on the merits.

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is  
not identically disclosed or described as set forth in section 102 of

this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-41, are rejected under 35 U.S.C. §103( a ) as being obvious over Horstmann US 6,285,985; class 705/14, (Sep. 04, 2001) [US f/d: 04/03/1998] (herein referred to as ("Horstmann").

As per independent claim 1, Horstmann (the ABSTRACT; FIG. 6; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 1; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) shows: "An advertisement supplying method, characterized in that an area for recording advertisement data is created in a large-capacity recording medium, advertisement data which are to be reproduced when an audience watch a program are recorded in said area in advance, and said large-capacity recording medium is thereafter provided."

Horstmann lacks an explicit recitation of the wording of independent claim 1, even though the cited disclosure of Horstmann implicitly shows same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Horstmann would have been selected in accordance with "An advertisement supplying method, characterized in that an area for recording

advertisement data is created in a large-capacity recording medium, advertisement data which are to be reproduced when an audience watch a program are recorded in said area in advance, and said large-capacity recording medium is thereafter provided. . . .” because selection of such features would have provided means of *“allowing a software developer to present advertisements through a software program. . . . The function of the advertisement module is to retrieve advertisements form an advertisement server and to display them to the user.”* (See Horstmann (col. 2, ll. 1-10)). Furthermore, the instant invention would have been rendered obvious in view of Horstmann, because the claims of the instant invention suffer from undue breadth.

Independent claim 2 is rejected for substantially the same reasons as independent claim 1.

As per claims 3-38, Horstmann shows the method and apparatus of claims 1 & 2 respectively and subsequent base claims depending from claims 1 & 2.

Horstmann (the ABSTRACT; FIG. 6; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 1; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) shows the elements and limitations of claims 3-38.

Horstmann lacks an explicit recitation of the elements and limitations of claims 3-38 even though the disclosure of Horstmann implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Horstmann would have been selected in accordance with the elements and

limitations of claims 3-38, be-cause selection of such features would have provided means of *“allowing a software developer to present advertisements through a software program. . . . The function of the advertisement module is to retrieve advertisements form an advertisement server and to display them to the user.”* (See Horstmann (col. 2, ll. 1-10)).

As per independent claim 39, Horstmann (the ABSTRACT; FIG. 6; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 1; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) shows: “In a system for displaying program data and sets of advertisement data on a display of a user having a storage medium, a method of sequencing program data and sets of advertisement data comprising the steps of . . . receiving sets of advertisement data and program data form a digital television broadcasting station . . . storing other sets of advertisement data n the storage medium . . . selectively synthesizing the program data received . . . with portions of the other sets of advertisement data stored . . . and . . . displaying the data synthesized. . . .”

Horstmann lacks an explicit recitation of the wording of independent claim 39, even though the cited disclosure of Horstmann implicitly shows same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Horstmann would have been selected in accordance with “In a system for displaying program data and sets of advertisement data on a display of a user having a storage medium, a method of sequencing program data and sets of advertisement data comprising the steps of . . . receiving sets of advertisement data and

program data from a digital television broadcasting station . . . storing other sets of advertisement data in the storage medium . . . selectively synthesizing the program data received . . . with portions of the other sets of advertisement data stored . . . and . . . displaying the data synthesized. . . .” because selection of such features would have provided means of *“allowing a software developer to present advertisements through a software program. . . . The function of the advertisement module is to retrieve advertisements from an advertisement server and to display them to the user.”* (See Horstmann (col. 2, ll. 1-10)). Furthermore, the instant invention would have been rendered obvious in view of Horstmann, because the claims of the instant invention suffer from undue breadth.

As per claims 40-41, Horstmann shows the method of claim 39.

Horstmann (the ABSTRACT; FIG. 6; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 1; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) shows the elements and limitations of claims 40-41.

Horstmann lacks an explicit recitation of the elements and limitations of claims 40-41 even though the disclosure of Horstmann implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Horstmann would have been selected in accordance with the elements and limitations of claims 40-41, because selection of such features would have provided means of *“allowing a software developer to present advertisements through a software program. . . . The function of the advertisement module is to retrieve advertisements from an advertisement server and to display them to the user.”* (See Horstmann (col. 2, ll. 1-

10)).

### CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

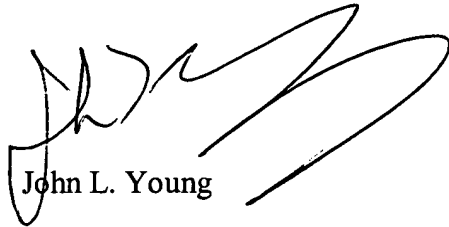
Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



**JOHN LEONARD YOUNG, ESQ.**  
**PRIMARY EXAMINER**

John L. Young  
Primary Patent Examiner

May 3, 2004